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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,508	04/12/2004	Leslie Yeh	Google-56CIP1 (GP-145-01-	3269
26479	7590	04/25/2008	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			ROBINSON, GRETA LEE	
			ART UNIT	PAPER NUMBER
			2168	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,508	<b>Applicant(s)</b> YEH ET AL.	
	<b>Examiner</b> Greta L. Robinson	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/27/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-28 are pending in the present application.
2. Claims 1-3, 7, 11, 13, 15-17, 21, 25 and 27 have been amended.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on September 27, 2007 has been considered by the examiner, note attached copy of form PTO 1449.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Note reference cite numbers AC and AE were not cited properly on form PTO 1449 (i.e. they did not have the correct document numbers). These references have been cited on form PTO-892 with the correct document numbers.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3 and 15-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 13-15 of copending Application No. 10/654265. Although the conflicting claims are not identical,

they are not patentably distinct from each other because it is well settled that the omission of elements and their functioning is an obvious expedient if the remaining elements and their functioning if the remaining elements perform the same function as before. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claims 1-3, a method for controlling the serving of an ad using its relevancy to a request [note: claims 1-3 of application serial no. 10/654265]. The claims are similar in scope except for the preamble and descriptive element of the geographical information being inter-country geolocation information.

Regarding claims 15-17 an apparatus for controlling the serving of an ad using its relevancy to a request [see: claims 13-15 of application serial no. 10/654265]. The claims are similar in scope except for the preamble and descriptive element of the geographical information being inter-country geolocation information. The limitation “means for accepting geolocation information” is interpreted as equivalent to “accepting geological information”, i.e. both limitations perform the same function.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the serving" in line 2. There is insufficient antecedent basis for this limitation in the claim. Also note similar limitation in the preamble of the following independent claims 11, 13, 15, 25 and 27 [see claim 11 line 2; claim 13 line 2; claim 15 line 2; claim 25 line 2; and claim 27 line 2]. Claims 2-10, 12, 14, 16-24, 26 and 28 are rejected based on dependency.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4, 11-18 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. US Patent 5,754,939 in view of Bandera et al. US Patent 6,332,127 B1.

Regarding claim 1, **Herz et al.** teaches a method for controlling the serving of an ad using its relevancy to a request [note: abstract customized electronic identification of desirable objects ], the method comprising:

a) accepting geolocation information associated with the request [note: col. 8 lines 46-67 the computed similarity measure serve as input at one or more locations in a data communications network; col. 9 lines 1-55 classical Information Retrieval System (IR) technology];

b) comparing the accepted geolocation information associated with the request with geolocation targeting information associated with the ad to generate a comparison [note: Figure 10 (1103) compare; also note col. 8 lines 46-67 through col. 9 lines 1-55];

c) determining the relevancy of the ad using at least the comparison, wherein the geolocation targeting information associated with the ad is defined by at least one geographic reference point [note: col. 10 lines 61-67 to col. 11 lines 1-67; Figure 10 (1108) ]; and

d) controlling the serving of the ad, for rendering on a client device, using the determined relevancy of the ad, wherein the geolocation targeting information associated with the ad is defined by at least one geographic reference point [note:

column 48 lines 7-27 access control criteria may be specified by the user to control transmission and requests of the target object ].

Although Herz teaches the invention as cited above, they do not explicitly teach that the customized electronic objects is geographical information. However, Bandera et al. teaches GPS information may be integrated into the web browser for advertisement retrieval systems [see: column 6 lines 40-55]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Bandera with Herz since Herz teaches that the data may be tailored to specific applications.

Regarding claim 2, Herz et al. teaches wherein the request further includes search terms, and wherein the act of determining the relevancy of the of further uses a result of a comparison of keywords ... [note: col. 57 lines 49-67 to col. 58 lines 1-24; col. 60 lines 7-67 to col. 61 lines 1-54].

Regarding claim 3, Herz et al. teaches wherein the request further includes document relevance information ... [note: col. 57 lines 49-67 to col. 58 lines 1-24].

Regarding claim 4, Herz et al. teaches wherein the geolocation targeting information corresponds to a circular area having a radius about a specified geographic [note: col. 10 lines 61-67; col. 11 lines 1-67].

9. The limitations of claims 15-18 parallel claims 1-4; therefor they are rejected under the same rationale.



10. Regarding claim 11, Herz et al. teaches a method for controlling the serving of an ad with respect to a request [note: abstract customized electronic identification of desirable objects ], the method comprising:

a) accepting geolocation information associated with the request [note: col. 8 lines 46-67 the computed similarity measure serve as input at one or more locations in a data communications network; col. 9 lines 1-55 classical Information Retrieval System (IR) technology];

b) comparing the accepted geolocation information associated with the request with geolocation targeting information associated with the ad to generate a comparison [note: Figure 10 (1103) compare; also note col. 8 lines 46-67 through col. 9 lines 1-55];

c) determining the score of the ad using at least the comparison, wherein the geolocation information is a zip code included in the request [note: col. 10 lines 61-67 to col. 11 lines 1-67 domain example ... zip code ; Figure 10 (1108); weights may be set by the administrator see col. 21 lines 44-57; also see col. 17 line 50 through col. 18 line 18 ]; and

d) controlling the serving of the ad, for rendering on a client device, using the score of the ad ...[note: column 48 lines 7-27 access control criteria may be specified by the user to control transmission and requests of the target object ].

Although Herz teaches the invention as cited above, they do not explicitly teach that the customized electronic objects is geographical information. However, Bandera et al. teaches GPS information may be integrated into the web browser for advertisement

retrieval systems [see: column 6 lines 40-55]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Bandera with Herz since Herz teaches that the data may be tailored to specific applications.

Regarding claim 12, wherein the request is a search query [note: col. 9 lines 4-7 IR technology].

Regarding claim 13, wherein the geolocation information is at least one of a city name, a street name ... [note: col. 11 lines 17-67 domain example].

11. The limitations of claims 14, and 25-28 parallel claims 11-13 therefore they are rejected under the same rationale.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

In the response Applicant argued the prior art does not teach determining the relevance of an advertisement for a given request using geolocation information.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., determining the relevance of an advertisement for a given request using geolocation information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note the claims have been amended and the previous claims did not include reference to a determination of relevance for a given request using geolocation information. However a newly cited reference Bandera et al. provides for information being geolocation information.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davis US Patent Application Publication No. 2001/0042064

Black US Patent Application Publication No. 2002/0016741

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/

Primary Examiner, Art Unit 2168

April 24, 2008